

REMARKS

In this application, claims 1-44 are pending. In the pending Office Action, Examiner Amareld made a restriction requirement between two identified groups of claims, which were characterized as follows:

- I. Claims 1-38, drawn to a grommet assembly, classified in class 606, subclass 60.
- II. Claims 39-44, drawn to a grommet assembly kit in a sterile packaged kit, classified in class 606, subclass 60.

The above language concerning the examiner's groups is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter or classification of any claim.

As Examiner Amareld's restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner. Accordingly, Applicants elect Group I (claims 1-38) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden. The Office Action suggests that the claim groups are related as combination and subcombination, and states that the claims are classified in the same class and subclass. Assuming that combination/subcombination assessment to be true, then all of the searching relevant to the subcombination will also be relevant to the combination. Respectfully, most or all of the searching required for group II will be the same as that for group I. Searching the subclass identified by the examiner, and those related to it, will be required for proper

examination of both sets of claims. Thus, not only will the subclasses of search be identical for

RESPONSE TO RESTRICTION AND
ELECTION REQUIREMENT

Application Serial No. 10/720,771

Attorney Docket No. 4002-3317

Page 2 of 5

both sets of claims, but the types of references sought in those subclasses will be at least highly similar, if not identical. Put another way, most or all of the references, if any, that are relevant to one set of claims will likely be relevant to the other set of claims. Since the research and analysis effort required for examining one set of claims will be essentially the same as for examining both sets of claims, it is respectfully submitted that there can be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and 808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species. This requirement is also traversed. Examiner Amareld indicated the opinion that this application includes claims directed to more than one species “of the claimed invention.” Specifically, the following species were identified:

Species A: Figures 1-3

Species D: Figures 9-10

Species B: Figures 4-6

Species E: Figure 11

Species C: Figures 7-8

The listing above is taken from the Office Action, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim or as to any embodiment disclosed in the application.

Examiner Amareld again relied on 35 U.S.C. § 121 in requesting that Applicants elect a single species. The Examiner added his opinion that no claims are generic. Section 121 permits limitation to a “reasonable number” of species. The embodiments shown and described in this application are a reasonable number for consideration, and the election requirement does not suggest otherwise. Further, the similarities among the embodiments are such that they can all be

efficiently considered together when the claims are searched and examined. On at least these legal and practical bases, the election requirement should be withdrawn.

Applicants elect Species A, with traverse. At least claims 1, 7-9, and 25 from the Examiner's Group I are generic to all of the species alleged by the Examiner, and others are generic to several of such species. For example, claim 18 is generic to at least Species A, C, D, and E alleged by the Examiner. Claims 39-44 of the Examiner's Group II are also generic to all of the alleged species. Applicants reserve the right to claim genericness of other claims later as may be appropriate. Further, examination of the claims with reference to all of the disclosed embodiments would not be burdensome, and would promote efficiency. Based on the existence of several generic claims and the lack of significant burden, Applicants respectfully request reconsideration and withdrawal of the election requirement.

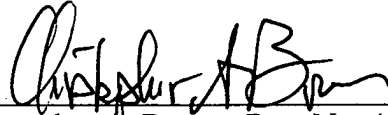
The Examiner has further requested a listing of the pending claims that read on the provisionally-elected species. That request is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application.

Given the breadth of the specification, at least claims 1-11, 15-16, and 18-38 from the Examiner's Group I and claims 39-44 from the Examiner's Group II read on the embodiment shown in FIGS. 1-3. Applicants do not concede the propriety of the Examiner's request, and do not intend to limit in any way the scope of the claims or this application with the above statement. Applicants reserve the right to take the position at a later time that other claims read on that embodiment as well, especially if the election requirement is not withdrawn.

No amendments have been made to the claims in this paper. The claims are intended to have the full scope permitted by their language.

In conclusion, Applicants have provisionally elected claims 1-38 of this application, with traverse, in response to the present restriction requirement. Applicants also have provisionally elected Species A with traverse. It is respectfully requested that Examiner Amareld reconsider the present restriction and election requirements and withdraw them. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Christopher A. Brown", is written over a horizontal line.

Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Chase Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

381460